

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q80002	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/802,717	March 18, 2004	
	First Named Inventor		
	Fumikazu SAITO		
	Art Unit	Examiner	
	1792	Nicole R. Blan	
<p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number 55,154</p> <p style="text-align: right;">_____/David P. Emery/ Signature</p> <p style="text-align: right;">_____ David P. Emery Typed or printed name</p> <p style="text-align: right;">_____(202) 293-7060 Telephone number</p> <p style="text-align: right;">_____ March 17, 2009 Date</p>			

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q80002

Fumikazu SAITO, et al.

Appln. No.: 10/802,717

Group Art Unit: 1792

Confirmation No.: 5046

Examiner: Nicole R. Blan

Filed: March 18, 2004

For: PROBE PIN CLEANING DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Further to the Examiner's Final Office Action dated December 17, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 1-2 and 7-8 under § 103(a) as being unpatentable over TeleChem, in view of Lord (US 4,442,852) in further view of Ferrell (US 5,505,785). Applicants traverse this rejection for the reasons set forth below.

This rejection is in error because the Examiner incorrectly asserts that Telechem discloses "a supporting member placed on a bottom of the cleaning container for supporting the fixing member; and an ultrasonic vibration generating

means for generating ultrasonic vibrations directed to the cleaning solution,” as recited in claim 1. Rather, Telechem fails to disclose and actually teaches away from any such feature. Accordingly, Applicants respectfully submit that TeleChem, taken alone or in combination with Ferrell and Lord, fails to disclose, at least, “a support member placed on the bottom of the cleaning container for supporting the fixing member” or “wherein the supporting member supports the fixing member above the cleaning solution such that a stylus portion of the probe pin is immersed in the cleaning solution,” as recited in claim 1.

In the Response to Arguments section of this Final Office Action, the Examiner makes several comments which directly contrast with the express disclosure of the Telechem reference.

In particular, the Examiner asserts:

- (1) Telechem teaches in Figures 1 and 2 that the legs of the support member hold the fixing member above the bottom of the tank; and
- (2) The Examiner is well aware that TeleChem suggests placing a certain amount of solution into the tank to prevent damage; however, this does not take away from the fact that the tank is able to have less than the amount of cleaning solution suggested as taught by the Telechem reference. Therefore, Telechem teaches the supporting member supports the fixing member above the cleaning solution so that a stylus portion of the probe pin is immersed in the cleaning solution.

(Office Action, pp. 2-3).

Consequently, the Examiner is improperly asserting that Telechem discloses a support member placed on the bottom of the cleaning container for supporting the fixing member. The Examiner’s contention is improper because: (1) Telechem fails to disclose any such feature; and (2) Telechem teaches away from using an amount of solution which is less than that which is required to keep the floatable rack floating.

First, Telechem expressly discloses that **nothing contacts the bottom of the tank.**

Rather, Telechem disclose a **floatable rack** which floats in the solution. (p. 3-9 of Telechem).

This express disclosure is in direct contrast to the recited “support member placed on the bottom of the cleaning container.”

Second, it is not obvious to modify Telechem’s floatable rack to rest on the bottom of the cleaning container by lowering the solution level because Telechem *expressly teaches away* from such a modification. In particular, Telechem discloses that the pin cleaning rack is a **floating** rack, thus it is designed to float above the bottom surface. (p. 3-9 of Telechem). Further, Telechem discloses that the ultrasonic bath is filled with liquid before the floating rack is placed in the ultrasonic bath. (p. 3) Finally, **Telechem discloses that the ultrasonic bath should not be operated with cleaning volumes that permit something to rest on the bottom of the tank or the Ultrasonic Bath may be damaged.** (p. 3). Notably, Telechem expressly teaches that this damage will result from something resting on the bottom of the tank. (*Id.*).

Consequently, Telechem’s disclosure is in direct contrast to the Examiner’s position regarding anything resting on the bottom of the bath and operating the bath with less than the amount of cleaning solution suggested. Because Telechem expressly teaches away from these features, Applicants also submit one of ordinary skill in the art would not modify Telechem to have these features. Rather, based on Telechem’s express teaching away, one of ordinary skill in the art would not find the requisite likelihood of success to make such a modification.

In conclusion, TeleChem’s fixing member (*see* p. 4) is not fixed above the cleaning solution, rather, TeleChem's pins are placed in a floatable pin cleaning rack. (p. 3, fig. 2). As

illustrated in figure 2, this floating pin cleaning rack floats on the surface of the cleaning solution. Consequently, there is no supporting member which supports the floatable pin cleaning rack above the cleaning solution. Additionally, because the pin cleaning rack is floatable, it is not placed on the bottom of the cleaning container. Furthermore, because Ferrell and Lord fail to disclose any supporting member which supports a fixing member above a cleaning solution, even if TeleChem, Ferrell and Lord are combined as suggested by the Examiner, the suggested combination fails to disclose all the features recited in claim 1.

Thus, Applicants respectfully submit claim 1 is allowable for at least this reason. Additionally, Applicants submit claims 2 and 7-8 are allowable, at least by virtue of their dependency.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claim 3 and 9 under § 103(a) as being unpatentable over TeleChem in view of Ferrell and Lord, and in further view of Jackson (David P. Jackson, *Centrifugal Shear Carbon Dioxide Cleaning* (Precision Cleaning '95 Proceedings)).

Applicants respectfully submit because Jackson, either taken alone or in combination with TeleChem, Ferrell and Lord, fails to compensate for the TeleChem/Ferrell/Lord combination as applied to claim 1, claims 3 and 9 are allowable, at least by virtue of their dependency.

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Conclusion

Thus, Applicants respectfully request that these rejections be withdrawn.

Respectfully submitted,

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